UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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ART UNIT	PAPER NUMBER
2132	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
	Office Action Summary	10/086,746	PARRY, TRAVIS J.
		Examiner	Art Unit	
		Laurel Lashley	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *18 October 2007*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,5, 8-17,20-21,24-34* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,5,8-17,20,21 and 24-34* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This action is in response to amendments filed 10/18/2007. Applicant's amendments

with respect to pending claims 1,5, 8-17, 20-21, 24-34 and cancelled claims 2-4, 6-7, 13-14, 18-

19, and 22-23 have been accepted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claim 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

3.   Claim 24 recites the limitation "the printing system". There is insufficient antecedent

basis for this limitation in the claim.

Response to Arguments

4.   Applicant's arguments filed 10/18/2007 have been fully considered but they are not

persuasive. It is Applicant's assertion that Rourke, Docter, and Kawamura patents, individually

or in combination, do not disclose a printer as claimed in independent claim 1, do not disclose a

method as claimed in independent claim 11, and do not disclose a system as claimed in

independent claim 20. Specifically, Applicant asserts that Docter does not disclose evaluating a

file at a printer and controlling printing of the file by the printer based on a prespecified

characteristic from a packet including the file, wherein processing of the file by the printer is

terminated and/or printing of the file by the printer is prevented if the prespecified characteristic

is an undesirable characteristic, and wherein processing of the file by the printer proceeds

and/or printing of the file by the printer is conducted if the prespecified characteristic is a desirable characteristic, as claimed in independent claim 1, 11 and 20.

5.   The Examiner observes that the Applicant is arguing against the references individually, and as a result offers that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6.   It is the combined disclosure of Rourke and Docter that meets Applicant's claim limitations. Rourke teaches a printing system (see Figure 1) which has been modified to include the filtering system of Docter (see Figure: 1: filtering system). Docter's filtering system, by virtue of a filtering system's functionality evaluates/analyzes files or documents based on specified characteristics, parameters, or criteria to determine (see column 3, lines 34-36), in view of Rourke, which files or documents are to actually be printed. It is obvious to one of ordinary skill in the art that a filtering system either enables or disables functionality from occurring. In this instance, the enabled or prohibited functionality is to process or terminate printing. As such the Examiner believes the combination of Rourke and Docter meets Applicant's claim limitation and therefore the rejection of claims 1, 5, 8 – 12, 15 – 17, 20 – 21, and 24-34 is maintained.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1, 5, 8 – 12, 15 – 17, 20 – 21, 26 – 28 and 30-34 are rejected under 35

U.S.C. 103(a) as being unpatentable over Rourke et al. in US Patent No. 5077795 (hereinafter

US '795) further in view of Docter et al. in US Patent No. 6330610 (hereinafter US '610).

As it relates to claim 1, and similar claims 11 and 20, US '795 teaches:

A printer, comprising: (see Figure 1)

a processor; and

a printing component in communication with said processor (see column 3, lines 33 -

38); and

but does not expressly disclose:

a filtering program stored in a memory device or firmware of said printer and associated

with said processor so as to evaluate a file received at said printer and control printing of said

file by said printing component based on at least one prespecified characteristic from a packet

including said file,

wherein if said at least one prespecified characteristics is an undesirable characteristic

processing of said file by said printer is terminated and printing of said file by said printer is

prevented, and

wherein if said at a least one prespecified characteristic is a desirable characteristic

processing of said file by said printer proceeds and printing of said file by said printer is

conducted.

Docter et al. however in US '610 does disclose a filtering program stored in a memory

device or firmware of said printer and associated with said processor (see Figure 10 and

column 9, lines 51 – 65) so as to evaluate a file received at said printer and control printing of

said file by said printing component based on at least one prespecified characteristic from a

packet including said file, (see Figure 11; column 1, line 66: a system for filtering data; column

10, line 10 – column 11, lines 1 – 7)

wherein if said at least one prespecified characteristics is an undesirable characteristic

processing of said file by said printer is terminated and printing of said file by said printer is

prevented, (see column 2, line 2: first filter criteria; column 10, lines 32 – 33: where filtering is

based on data received; and column 2, lines 14 – 15: where the profile data set contains

elements associated with particular class of recipients) and

wherein if said at a least one prespecified characteristic is a desirable characteristic

processing of said file by said printer proceeds and printing of said file by said printer is

conducted. (see column 2, line 5: second filter criteria; see column 10, line 62: where filter

data processing code determines the destination of packet)

At the time of the invention, it would have obvious to one of ordinary skill in the art to

modify the printing system of Rourke et al. such that it would incorporated a filtering program as

in Docter et al. The motivation for doing so would have been to provide security to printing

devices.

For claim 5, and similar claims 12 and 26, US '795 teaches the printer of claim 1 *but*

does not expressly disclose, wherein said at least one prespecified characteristic comprises at

least one of a file type, a source computer identifier, a user identifier, a file size, a password,

time of transmission, cumulative number of files sent by a user, cumulative number of files sent

by a user over a given time, file string, and time-consuming print commands.

Docter et al. however in US '610 does disclose wherein said at least one prespecified

characteristic comprises at least one of a file type, a source computer identifier, a user identifier,

a file size, a password, time of transmission, cumulative number of files sent by a user,

cumulative number of files sent by a user over a given time, file string, and time-consuming print

commands. (see column 3, lines 30 – 40: any number of filtering parameters or attributes may be used to filter data).

At the time of the invention, it would have obvious to one of ordinary skill in the art to modify the printing system of Rourke et al. such that it would incorporated a filtering program with filtering guidelines as in Docter et al. The motivation for doing so would have been to provide security to printing devices by identifying characteristics that are undesirable for printing.

For claim 8, and similar claims 15 and 28, US '795 teaches the printer of claim 1, *but does not expressly disclose* wherein said filtering program instructs said processor to cause said printing component to print said file only if said packet lacks said undesirable characteristic and has said desirable characteristic.

Docter however does disclose wherein said filtering program instructs said processor to cause said printing component to print said file only if said packet lacks said undesirable characteristic and has said desirable characteristic (column 3, line 17: where unwanted data is eliminated).

At the time of the invention, it would have obvious to one of ordinary skill in the art to modify the printing system of Rourke et al. such that it would incorporated a filtering program with filtering guidelines as in Docter et al. The motivation for doing so would have been to provide security to printing devices by identifying characteristics that are undesirable for printing.

For claim 9, and similar claim 16, US '795 teaches the printer of claim 1, *but does not expressly disclose* wherein said undesirable characteristic comprises one of a file type, a file string, a source computer identifier, a user identifier, a file size, and at least one prespecified command.

Docter however does disclose wherein said undesirable characteristic comprises one of a file type, a file string, a source computer identifier, a user identifier, a file size, and at least one

prespecified command (column 2, line 2; and column 3, lines 34 – 40: criteria designated within specified criteria).

At the time of the invention, it would have obvious to one of ordinary skill in the art to modify the printing system of Rourke et al. such that it would incorporated a filtering program with filtering guidelines as in Docter et al. The motivation for doing so would have been to provide security to printing devices by identifying characteristics that are undesirable for printing.

For claim 10, and similar claim 17, US '795 teaches the printer of claim 1, *but does not expressly disclose* wherein said desirable characteristic comprises one of a source computer identifier, a user identifier, a file type, and a password.

Docter however does disclose wherein said desirable characteristic comprises one of a source computer identifier, a user identifier, a file type, and a password (column 2, line 5; and column 3, lines 34 – 40).

At the time of the invention, it would have obvious to one of ordinary skill in the art to modify the printing system of Rourke et al. such that it would incorporated a filtering program with filtering guidelines as in Docter et al. The motivation for doing so would have been to provide security to printing devices by identifying characteristics that are suitable for printing.

For claim 21, US '795 teaches the system of claim 20, and a memory device and firmware (see Figure 1) *but does not expressly disclose* wherein said filtering program is stored by at least one of a memory device and firmware.

Docter however does disclose wherein said filtering program is stored by at least one of a memory device and firmware (see column 3, lines 20 – 22).

At the time of the invention, it would have obvious to one of ordinary skill in the art to modify the printing system of Rourke et al. such that it would incorporated a filtering program

with filtering guidelines as in Docter et al. The motivation for doing so would have been to provide security to printing devices.

For claim 27, US '795 discloses the system of claim 20, includes instructions for said printer, the instructions comprising information about a source of media onto which printing of said at least one file is to be effected, information about orientation in which said at least one file is to be printed on a media, information about whether printing is to be effected on one or two sides of a media, information about a number of copies to be printed, or information about whether multiple copies should be collated (see Figure 1 and associated text: where these instructions are inherent features of a printing system).

For claims 30 – 34, US '795 discloses the printer of claim 1 but does not expressly disclose wherein said undesirable characteristic comprises: a file having a certain extension; file including a particular file string; file size exceeding a maximum threshold; one of an identifier for a prespecified source computer and an identifier for a prespecified user; a time-consuming print command. (see column3, lines 30-40: any number of filtering parameters or attributes may be used to filter data)

8.   Claims 24 – 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rourke et al. in US Patent No. 5077795 (hereinafter US '795) and Docter et al. in US Patent No. 6330610 (hereinafter US '610) further in view of Kawamura in US Patent No. 5731882 (hereinafter US '882).

For claim 24 and similar claims 25 and 29, US '795 teaches the printing system of claim 1, *but does not expressly disclose* wherein a message is generated if said at least one prespecified characteristic is said undesirable characteristic and processing of said file is terminated.

Kawamura however in US '882 does disclose wherein a message is generated if processing of said file is terminated. (see column 9, lines 45 – 58: message "printer error"...) *but does not expressly* disclose at least one prespecified characteristic is said undesirable characteristic.

Docter however in US '610 does disclose at least one prespecified characteristic is said undesirable characteristic ((see column 2, line 2: first filter criteria; see column 10, lines 32 – 33: where filtering is based on data received; and column 2, lines 14 – 15: where the profile data set contains elements associated with particular class of recipients).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the printing system of Rourke et al. such that it would incorporate a filtering program with specified parameters and characteristics of files to be printed as in Docter et al. such that if printing of a file was prevented, a message would be generated to inform the user as in Kawamura. The motivation for doing so would have been to alert the user of a printing error.

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shima in US Patent No. 6149323 discloses a print system, printer controller, printer, and printer control method..

10.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date

of this final action.

11.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Laurel Lashley whose telephone number is 571-272-0693. The examiner

can normally be reached on Monday - Thursday, alt Fridays btw 7:30 am & 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron, Jr. can be reached on 571-272-3799. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Laurel Lashley
Examiner
Art Unit 2132
LLL
04 January 2008

GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100